

3738

PATENT

Attorney Docket No. 018880.0120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inter Patent Application of:

J. Donald HILL et al.

Application Number: 09/987,976

Filed: November 16, 2001

For: AUTOMATIC SUTURE FIXATION  
APPARATUS AND METHOD FOR  
MINIMALLY INVASIVE CARDIAC  
SURGERY

Group Art Unit: 3738

Examiner: Thomas C. BARRETT

Confirmation No. 3738

#10  
Election  
S. Baya  
12/17/03

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
U.S. Patent and Trademark Office  
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

In the Restriction Requirement mailed November 19, 2003, in the above-captioned patent application, Applicants are required to elect between two (2) allegedly, patentably distinct groups of claims, each identifying an allegedly distinct invention, and between five (5), allegedly, patentably distinct species within each group, for prosecution in this application. The Restriction Requirement identifies the following allegedly, patentably distinct groups of claims and species, and Applicants believe the pending claims within each group are associated with the identified species, as follows:

Group:

Description:

I (Claims 1-24 and 41-43)

Drawn to a suture fixing apparatus classified in  
Class 606, Subclass 139

Species:

Associated Claims:

Species I (Fig. 1)

Claims 1, 2, 4-13, 15-20, 22-24, and 41-43

Species II (Fig. 2-1)

Claims 1, 2, 4-13, 15-20, 22-24, and 41-43

Species III (Figs. 2-2 thru 3-2)

Claims 1, 2, 4-13, 15-20, 22-24, and 41-43

Species IV (Figs. 4 and 7 thru 11)

Claims 1, 2, 4-13, 15-20, 22-24, and 41-43

Species V (Fig. 5)

Claims 1, 2, and 41-43

Group:

Description:

II (Claims 25-40)

Drawn to a method of implanting a heart valve,  
classified in Class 128, Subclass 898

Species:

Associated Claims:

Species I (Fig. 1)	Claims 25-40
Species II (Fig. 2-1)	Claims 25-40
Species III (Figs. 2-2 thru 3-2)	Claims 25-40
Species IV (Figs. 4 and 7 thru 11)	Claims 25-40
Species V (Fig. 5)	Claims 25-34, 39, and 40

The Restriction Requirement asserts that no claim is generic to all species. Nevertheless, Applicants maintain that that claims 1, 2, and 41-43 are generic to the species of Group I and that claims 25-34, 39, and 40 are generic to the species of Group II, and that several other claims, e.g., claims 4-13, 15-20, 22-24, and 35-38 are generic to two or more species, as indicated above. **Applicants elect to pursue Group I, Species I (Fig. 1; claims 1, 2, 4-13, 15-20, 22-24, and 41-43), with traverse.**

According to the Manual of Patent Examining Procedures (MPEP), an election of species requirement is appropriate only when the species are shown to be distinct and when a “serious burden” would be placed on the Examiner to examine more than one species of the invention. See MPEP §§ 802.02, 803. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP 803. MPEP § 803 provides that “[e]xaminers must provide reasons and/or examples to support conclusions . . . .” (Emphasis added.) In particular, according to MPEP § 808.02, “[w]here the related inventions as claimed are shown to be distinct under the criteria of [MPEP § 806.05(d)], the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following [accepted reasons]:” (A) Separate classification thereof, (B) Separate status in the art when they are classifiable together, and (C) A different field of search. (Emphasis added.)

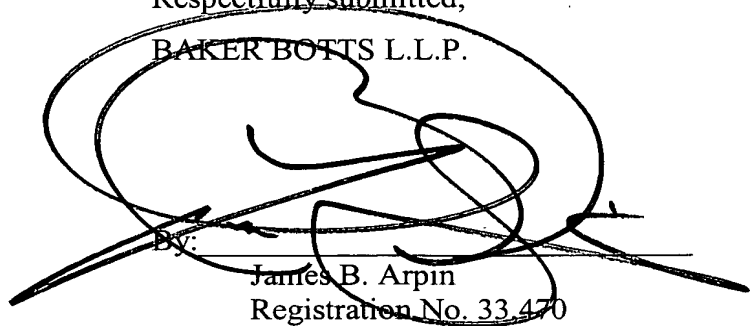
Although the Restriction Requirement asserts that Groups I and II are classified separately, Applicants maintain that the Restriction Requirement fails to provide a reason approved by the Director demonstrating that a serious burden would be placed on the Examiner to examine more than one species of the elected group in this application. See MPEP 808.01(a) and 808.02. Because the Restriction Requirement merely asserts that the

species are patentably distinct and fails to provide any reasons to justify the restriction or to establish a prima facie showing of a serious search and examination burden, Applicants maintain that this requirement for election is improper. In addition, each alleged species relates generally to automatic suture fixation apparatus. Consequently, the search of any of the elected species seems likely to uncover relevant art relating to the unelected species, and that any additional searching, which may be required, would not place a significant burden upon the Examiner. In view of the foregoing remarks, Applicants respectfully traverse the restriction requirement and requests that the Examiner reconsider and withdraw the election of species requirement within each group.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicants' representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity. No fees are believed due as a result of this filing. Nevertheless, in the event of any variance between the fees determined by Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,  
BAKER BOTTS L.L.P.



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